



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/082,115 | 02/26/2002 | Masahide Hoshino | 219865US0 | 3520 |
| 22850 | 7590 | 07/01/2004 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. | | | YU, GINA C | |
| 1940 DUKE STREET | | | ART UNIT | |
| ALEXANDRIA, VA 22314 | | | PAPER NUMBER | |

1617

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/082,115 | Applicant(s) HOSHINO ET AL. | |
| | Examiner Gina C. Yu | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>February 13, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed March 18, 2004. Claims 1-6, 14-25 are pending. Claim objection on claim 14 is withdrawn in view of claim amendment. Claim rejection made under 35 U.S.C. § 102(e) as indicated in the previous Office action dated December 18, 2003, is withdrawn in view of claim amendment. Claim rejection made under 35 U.S.C. § 103(a) as indicated in the same Office action is withdrawn in view of claim cancellation. New rejection is made based on a reference cited in information disclosure statement submitted by applicants on February 13, 2004. New rejection is also necessitated by newly submitted claims and claim amendment.

Allowable Subject Matter

Claim 14 is allowed.

The indicated allowability of claims 2 and 3 is withdrawn in view of IDS submitted on March 17, 2004. Rejections based on the cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 17, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Robbins et al. US 4626429 ("Robbins").

Art Unit: 1617

US 4626429 is an English equivalent of DE 3617407 A, cited in IDS filed March 18, 2004.

Robbins discloses diamides which meet the formula (I) and its constituents of instant claims 1, 5, and 6. The presently claimed diamide derivative, when R^{1a} and R^{1b} are C_4 , R^{2a} and R^{2b} are C_1 , R^3 is C_1 , and $n=1$, reads on the prior art diamide shown at col. 6, lines 1-5 when T is hydrogen, $n=1$, and R is C_4 . The reference teaches using less than 20 % of the diamide in a hair shampoo or hair conditioning products. Col. 8, line 63 – col. 9, line 13. See the weight amount of instant claims 17, 20, and 23 are disclosed at col. 9, line 14 – 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 15, 16, 18, 19, 21, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins as applied to claims 1, 4-6, 17, 20, and 23 as above, and further in view of Murray (US 6277361 B1).

Robbins teaches the use of the claimed diamide as a hair conditioner. While Robbins generally teaches that cationic, anionic, and nonionic surfactants are used in shampoo compositions, the reference fails to teach “intercellular lipid component of the horny layer” or specific formulation comprising the diamide.

Murray teaches that it is well known in hair cosmetic art that ceramides moisturize hair fibre and maintain "cuticle integrity". See col. 8, lines 42 – 49. See instant claims 2 and 3. Also shown is a hair conditioning shampoo formulation comprising 14 % sodium lauryl sulphates (anionic surfactant) and silicone oil emulsions comprising cationic surfactant and nonionic surfactant. See col. 8, line 35- col. 9, line 15. Nonionic surfactant is taught in col. 2, lines 13 – 31. The reference teaches that surfactants are present in shampoo compositions in an amount of 0.1-50%, and most preferably from 10-25 % by weight. See col. 2, lines 43-46. See also col. 1, line 14-49, for the disclosure that the shampoo conditions the hair leaving it "softer and more manageable".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Robbins by formulating a conditioning shampoo composition as motivated by Murray because 1) Robbins teaches to use the diamide as a hair conditioning agent between shampoos; 2) Murray teaches a conditioning shampoo formulation. The skilled artisan would have been motivated to combine the references in expectation of successfully formulating a conditioning shampoo which cleanses and conditions the hair.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 14-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Claim 14 is allowed.

Claims 1-6 and 15-25 are rejected.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on March 17, 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

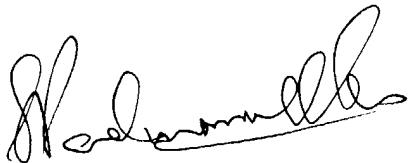
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629.

Art Unit: 1617

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER